

REMARKS

This submission responds to the Official Action mailed on November 30, 2005.

The following comments are made with respect to each of independent claims 1, 6, 12, and 21, except when a specific pending claim is being discussed.

Amendments to claims 1 and 12 are made in order to include the transition phrase “comprising the steps of” lest there be any question that these claims are directed to an open-ended methodology that includes the steps recited in those claims, and at least the features of the claims that depend therefrom.

Section 101 Rejection As To All Claims

The Patent Office has stated for the first time in this prosecution that the claims recite non-functional descriptive material in contravention of Section 101 of the Patent Act. The Patent Office’s determination is respectfully traversed. The use of computer hardware to perform most of the steps in these claims, to the extent not expressly recited in such steps, is an implicit feature. Amendments have been made to the independent claims to make express the implicit fact that the claimed methods are implemented through the use of machines.

Claim 1 is directed to a process in which each step includes the use of hardware (either a client machine or a server). By the present amendment, the method of claim 1 recites that these hardware components are utilized by virtue of the method being implemented on a network which includes a client machine and a server.

Claim 6 is directed to a process in which steps (a), (b), (c) and (e) include the use of hardware (either a client machine or web site). By the present amendment, the method of claim 6 recites that these hardware components are utilized by virtue of the method being implemented on a network which includes a client machine and a Web site.

Claim 12 is directed to a process in which each step includes the use of hardware (either a telephone or a server). By the present amendment, the method of claim 12 recites that these hardware components are utilized by virtue of the method being implemented on a network which includes a telephone and a server.

Claim 21 is directed to a process in which each step includes the use of hardware (either a client machine or a server). By the present amendment, the method of claim 21 recites that these hardware components are utilized by virtue of the method being implemented on a network in which the network includes plural client machines and a server associate with the Web site.

The present amendments were prompted by the Patent Office's contention that the claims are directed to a method which "reads on a mental construct/abstract idea or at best a computer program, per se." Despite the clear recitation of hardware in the steps of these claimed methods, the present amendment is to clarify the environment of the invention without narrowing the scope of the recited method steps. If the Patent Examiner disagrees, then Applicant requests that he state that position on the record because Applicants have no intention of narrowing the steps of the methods of the independent claims in view of hardware.

Section 112 Rejection As To Claim 9

Claim 9 has been amended to delete reference "to more evenly distribute voice clips". As amended, claim 9 now more broadly notes that the voice clips in the playlist are compiled for distribution to plural users, and the perceived indefiniteness has been removed. Withdrawal of this ground for rejecting claim 9 is respectfully requested.

Section 103(a) Rejection of Claims 1, 6, 12 and 21

Claims 1-17 and 19-24 stand rejected over Zhang in view of Fennell. Applicant respectfully traverses this rejection.

Discussion of Prior Art Relative to Claim 1

Zhang et al. describe a system that searches for musical files on the basis of a melody or portion of a melody rather than a text string input. A person initiates a search by inputting the melody, for example, using a microphone. In this regard, Zhang et al. is pertinent to the methods recited in the independent claims.

The Zhang et al. system uses server programs and a database to execute searches and to respond to its user with a match, once found. Of course, the entire purpose of Zhang et al.'s system is to inform the user of the *match*, not a 'guess.'

The Patent Office has acknowledged several deficiencies in Zhang et al. relative to the invention defined by claim 1, including that Zhang et al. does not teach or suggest the steps of (1) making voice clips available to human visitors to the server or (2) permitting such human visitors to post identifications of the song to the server. For these features, the Patent Office proposes that persons of ordinary skill would modify Zhang et al. to include the public participation described by Fennell et al.; however, that combination does not result in the invention of claim 1.

Fennell et al. describe a multiplayer game which is played over a network such as the Internet. Players respond to challenge questions in order to gain control and to be the only player that gets to make the next move such as to "NAME MY TUNE" in a certain number of notes. However, what must be appreciated is that the challenge questions of Fennell et al. result in one player having his terminal awarded "control" while all other players have their terminals "locked out." Locked out terminals (players) await the next challenge question in order to participate in the game. Only the terminal in "control" can try to name a tune, etc. The winner of the challenge question thus responds to NAME MY TUNE, for example, with a guess as to the correct answer (the song title, in this example), and Fennell et al. references an answer file to determine if the guess was correct. *See, e.g.*, col. 5, lines 45-46.

Thus, Fennell et al. contemplate known questions with known answers. However, when the melody is sourced by a user of Zhang et al., the answer is unknown. Of course, the Zhang et al. user sings the melody for the precise purpose of identifying an *unknown* song.

The proposed modification of Zhang et al. eliminates the purpose of the server programs, the database query, and the entire algorithmic matching process that Zhang et al. teach. In place of all of that, the proposed modification has the Zhang et al. user's melody sent out as a Fennell et al. "challenge question." This occurs in the midst of a multiplayer game that would have had to have already been convened. The players in that existing game then "buzz"-in a race-like challenge or by bid (I can name the tune in 10 notes, etc.) in order to gain control and not be "locked out." The controlling player guesses at the Zhang et al. user's song. However, the correct answer to the challenge question in the modified system as proposed by the Patent Office is not included in any answer file. Rather, the Zhang et al. user sings an unknown melody, with multi-players of Fennell et al. competing for control and a chance to respond to that challenge. Thus, the proposed

modification results in multi-players guessing at an unknown song for which there is no answer in the answer file.

Accordingly, the proposed combination does not teach or suggest the method of claim 1.

Independent Claim 6

With regard to claim 6, the Patent Office refers to its rejection of claim 1 and articulates that the use of speakers to play a voice clip at a client machine is within the scope of the disclosure of Zhang et al. and that the step of awarding a benefit is obvious from Fennell et al. because Fennell allows public participation in games over the Internet. Applicant respectfully traverses this rejection.

Zhang et al. teaches that a “voice clip” (an input entered by “Method 4” of “Drawing 2”) is downloaded to the server, but it is never sent to other client machines or to a community of users who selectively provide responses and receive awards for doing so. The server of Zhang et al. has the principal components necessary to resolve the query and provide a response to the client machine without human intervention, and that is why the “voice clip” is downloaded to the server.

The proposed combination with the game of Fennell et al. has the voice clip provided to the terminals of multiple players (step a), which are played out at those terminals (step b), and a responsive guess is selectively provided (step c), and if the answer file confirms the response as being correct, a benefit may be awarded (step d). However, this analysis is flawed in that the proposed combination of Zhang et al. with Fennell et al. is unsupportable at least because Fennell et al. is inoperative without having an answer file available for confirming the correctness of the guess. Further, even were there a reason to combine the references as proposed (which there is not) and even if the proposed combination described an operative system (which it does not), there is no teaching or suggestion that the voice clip author is notified that a criterion has been satisfied.

Consequently, the proposed combination does not teach or suggest the method of claim 6.

Claim 12

In rejecting claim 12 over the combination of Zhang et al. in view of Fennell et al., the Patent Office refers to its rationale expressed relative to claim 1, which does not render claim 12 obvious for the reasons noted above.

Applicant further notes that claim 12 recites features in addition to those recited in claim 1 which further differentiate over the proposed combination of references. The client machine of this claim is embodied in a telephone and the step of “inputting a voice clip of a portion of the song into a microphone” further includes inputting first user identification information which is used in the receiving step “in response to receipt of the first user identification information.” The proposed combination does not describe or suggest the use of such information.

Claim 21

In rejecting claim 21 over the combination of Zhang et al. in view of Fennell et al., the Patent Office refers to its rationale expressed relative to claims 1 and 6, which does not render claim 21 obvious for the reasons noted above. In particular, the proposed modification lacks an answer file and therefore is not able to provide the an electronic notification to the first client machine (used by the human user who sang the input song) concerning the name of the song in the voice clip.

Separate Basis for Withdrawing Rejection Against Independent Claims

The proposed modification cannot render a prior art document unsatisfactory for its intended purpose, and the Fennell et al. system would not work if there were no answer file to determine whether the player in control is correct, and the Zhang et al. system would not work in the proposed modified system because it has been gutted of its melody-processing engine. Accordingly, the rejection combining Zhang et al. with Fennell et al. should be withdrawn for this further reason. *See* Manual of Patent Examining Procedure, § 2143.01.

